



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,484	01/23/2004	Nausheen Moulana	MWS-107	7031
959	7590	09/11/2007		
LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127			EXAMINER ZEE, EDWARD	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,484

Applicant(s)

MOULANA ET AL.

Examiner

Edward Zee

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the amendment filed on July 5th, 2007. Claims 6, 7, 9, 10, 16, 17, 22 and 24 have been amended and Claims 1-24 are pending and have been considered below.

Response to Amendment

2. The amendment filed on July 5th, 2007 has been considered but is ineffective to overcome the Cookson et al. (5,896,454) reference.

Specification

3. The amendment filed on July 5th, 2007 has been considered and is effective to overcome the previous objections. Therefore, the objections to the specification have been withdrawn.

Claim Objections

4. The amendment filed on July 5th, 2007 has been considered and is effective to overcome the previous objections. Therefore, the objections to the claims have been withdrawn.

Claim Rejections - 35 USC § 112

5. The amendment filed on July 5th, 2007 has been considered and is effective to overcome the previous rejections. Therefore, the 35 U.S.C. § 112 rejections have been withdrawn.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 1, 4, 5, 7, 8, 9, 18-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Cookson et al. (5,896,454).**

Claims 1, 4 and 21: Cookson et al. discloses a method and computer-readable optical medium containing instructions for preventing use of an unauthorized copy of a software program comprising the steps of:

- a. determining a media type of an optical medium containing the software program [column 5, lines 23-27];
- b. and inhibiting execution(*further play is aborted*) of the software program stored on the optical medium by preventing execution of the software program if the optical medium has media type that indicates that the optical media is copied [column 5, lines 44-49].

Claim 5: Cookson et al. discloses a method as in claim 1 above and further discloses that the step of determining the media type comprises inserting the optical medium in a drive of a computer and reviewing a medium-type code field contained in a mode parameter header(*lead-in section*) of the optical medium [column 3, lines 22-27].

Claim 7: Cookson et al. discloses a method as in claim 1 above and further discloses that a media type indicates that the optical medium is copied is one of a write-once media type and an erasable/rewriteable media type(*writeable disk*) [column 2, lines 24-25 and column 5, lines 39-48].

Art Unit: 2135

Claim 8: Cookson et al. discloses a method as in claim 1 above and further discloses the step of executing the software program stored on the optical medium if the step of determining determines the optical medium to be an optical read-only medium [column 5, lines 23-27].

Claim 9: Cookson et al. discloses a method as in claim 1 above and further discloses the step of searching for a file on the optical medium containing the software program prior to determining the media type to ensure that the optical medium contains the software program [column 2, lines 24-25 and column 5, lines 23-27]. The examiner notes that it is inherent to first find the medium type code stored in the lead-in section of the disk before being able to determine the media type.

Claims 18 and 23: Cookson et al. discloses a method and computer-readable optical medium containing instructions for preventing execution of an unauthorized copy of a software program stored on an optical medium comprising the steps of:

- a. determining a media type of the optical medium [column 5, lines 23-27];
- b. and executing the software program stored on the optical medium if the optical medium has a media type that indicates that the optical medium is an original version(*pressed disk*) [column 5, lines 23-27].

Claim 19: Cookson et al. discloses a method as in claim 18 above and further discloses that a read-only media type indicates that the optical medium is an original version [column 5, lines 23-27].

Claim 20: Cookson et al. discloses a method as in claim 18 above and further discloses the step of inhibiting execution of the instructions if the optical medium does not have a read-only media type [column 5, lines 44-49].

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 2, 3, 6, 10-17, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cookson et al. (5,896,454).**

Claims 2 and 3: Cookson et al. discloses a method as in claim 1 above, but does not explicitly disclose that the step of inhibiting the execution of the software program comprises preventing execution of selected features of the software program by determining a set of features of the software program to execute. However, it would have been obvious to one of ordinary skill in the art at the time of invention to prevent execution of selected features of the software program. One would have been motivated to do so in order to allow execution of insignificant features of the software such as trial versions, previews, or purchasing information.

Claim 6: Cookson et al. discloses a method as in claim 5, but does not explicitly disclose that the drive is a CD-R/W drive. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Claims 10 and 22: Cookson et al. discloses a method and computer-readable optical medium containing instructions for authenticating an original optical medium comprising the steps of inserting the optical medium in a drive of a computer(*player/recorder*) and checking a media type of the optical medium [column 4, lines 64-67 and column 5, lines 23-27], but does not explicitly disclose that the drive is a CD-R/W drive. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other

optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Claim 11: Cookson et al. discloses a method as in claim 10 above and further discloses the step of searching for a file on the optical medium prior to checking the media type [column 2, lines 24-25 and column 5, lines 23-27]. The examiner notes that it is inherent to first find the medium type code stored in the lead-in section of the disk before being able to determine the media type.

Claim 12: Cookson et al. discloses a method as in claim 10 above and further discloses that the step of checking a media type comprises reviewing a medium-type code field contained in a mode parameter header(*lead-in section*) of the optical medium [column 3, lines 22-27].

Claims 13-15: Cookson et al. discloses a method as in claim 10 above and further discloses:

a. the step of checking the media type comprises verifying that the optical medium has a read-only media type and that it is indicative that the optical medium is an original version(*pressed disk*) [column 5, lines 23-27];

b. the step of executing a software program stored on the optical medium if the optical medium has a read-only media type [column 5, lines 23-27] .

Claim 16: Cookson et al. discloses a method as in claim 10 above and further discloses that the step of checking the media type comprises identifying if the media type is one of a write-once media type and an erasable/rewritable media type(*writeable disk*) [column 2, lines 24-25 and column 5, lines 23-27].

Claim 17: Cookson et al. discloses a method as in claim 16 above and further discloses the step of inhibiting execution of a software program stored on the optical medium if the step of

Art Unit: 2135

checking identifies that the media type is one of a write-once media type and an erasable/rewritable optical media type [column 5, lines 39-48].

Claim 24: Cookson et al. discloses an electronic device comprising:

a. memory for storing computer program instructions. The examiner notes that it is inherent for the device to have memory for storing computer program instructions if the device is executing the instructions;

b. a processor for executing the stored computer program instructions [column 4, lines 42-43];

c. and an optical drive(*player/recorder*) for receiving an optical medium containing a software program, the computer program instructions including instructions for determining the media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the optical medium has media type that indicates that the optical medium is copied, but does not explicitly disclose that the optical drive is a CD-R/W drive [column 4, lines 40-42].

However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Response to Arguments

10. Applicant's arguments filed on July 5th, 2007 have been fully considered but they are not persuasive.

Art Unit: 2135

Regarding Claims 1, 18, 21 and 23: The Applicant argues that Cookson et al. does not disclose inhibiting the execution of a software program or a software program stored on an optical medium and that it merely “discusses the well-known art of inhibiting play of audio, video or data disks”. However, the Examiner respectfully disagrees and submits that while Cookson et al. employs a “digital video recording” throughout the reference, this is meant as an example to help illustrate the concept and does not limit the invention to only “digital video recordings”.

Furthermore, Cookson et al. discloses, “*writeable medium is one on which digital data can be recorded regardless of what is represented by that data, i.e. any kind of “program”, audio, video, audio-visual, text or data, or any combination thereof*” [column 2, lines 31-35].

Regarding Claim 3: The Applicant argues that in addition to the shortcomings as set forth in Claim 1, Cookson et al. does not disclose “determining a set of features to execute” and only discloses completely aborting further play with regard to unauthorized copies of audio-visual disks. However, the Examiner respectfully disagrees and submits that Cookson et al. discloses various levels of copy protection states, such as “no restriction”(free to copy or playback), “first generation copy”(only one copy allowed and free to playback), “no copies allowed”(free to playback only) and finally “no copies ever”(free to playback only if on proper media type, if not, then no playback allowed). Furthermore, the Examiner notes that it is common for digital video disks(DVD) to contain more than merely an audio-visual segment, such as a “main menu”, where a plurality of features(ie. advertisement previews, documentaries regarding the making of the movie, extra scenes, etc.) may be selected and executed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to not only allow different states of execution of the DVD itself but to also allow select features to remain operable or

Art Unit: 2135

inhibited depending on the current level of copy protection. For example, this may be advantageous in situations where a DVD has been illicitly copied, but the production company would still like the user of the copy to view the advertisement previews or perhaps even the extra scenes in hopes of enticing the user to purchase a legitimate copy. Furthermore, this would be the same concept as “trial versions” of software, where a fully functional software program is functionally limited (ie. restrict use of important features of the program) and distributed freely in hopes to attract the user of such “trial version” into purchasing the complete version after experiencing a sample of the features the full version has to offer.

Regarding Claim 10: The Applicant argues that Cookson et al. does not disclose “inserting the optical medium in a CD-RW drive of a computer” and “checking a media type of the optical medium”. However, the Examiner respectfully disagrees and submits that while figure 2 of the reference does in fact illustrate the disk in an “ejected” position, the disc would eventually be “inserted” into the device before the disc may be read. The Examiner further notes that Cookson et al. discloses, “a digital video disk player is capable of determining the kind of disk it is playing” [column 3, lines 22-23].

Regarding Claim 22: The Applicant argues that Cookson et al. does not disclose “detecting insertion of the optical medium in a CD-RW drive of a computer” and “checking a media type of the optical medium”. However, the Examiner respectfully disagrees and submits that Cookson et al. discloses, “when a new disk is inserted into the player/recorder, the system first determines whether the disk is to be played, etc...” [column 4, lines 65-67]. Therefore, the player/recorder would at the very least have to detect the insertion of the disk before determining what operation(s) to perform on the disk.

Regarding Claim 24: The Applicant argues that Cookson et al. does not disclose “a CD-RW drive for receiving an optical medium containing a software program, the computer program instructions including instructions for determining the media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the optical medium has media type that indicates that the optical medium is copied” for the reason already discussed in Claim 1 above.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Zee whose telephone number is (571) 270-1686. The examiner can normally be reached on Monday through Thursday 9:00AM-5:00PM EST.

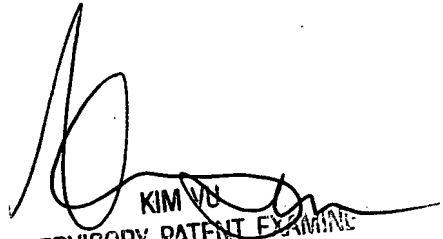
Art Unit: 2135

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EZ

August 29, 2007


KIM YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100